

Application No.: 10/696088
Docket No.: FA1062USNA

Page 5

REMARKS

Claim Objections

Claim numbering has been objected to in that two different claims were numbered as claim 25 in the original. This has been corrected by renumbering the second claim 25 as claim 26, and renumbering original claim 26 as claim 27. Renumbered claims 26 and 27 are further amended to correct dependency to original claim 25 (independent process claim) instead of claim 24 (dependent composition claim). Applicants wish to thank the Examiner for pointing out the claim numbering errors.

Claim 9 has been objected to for including (meth)acrylate in line 2 of the claim. The Examiner stated that it is unclear what alkyl group it refers to. Claim 9 recites that the non-functional (meth)acrylate monomer (referring to claim 4, which in turn depends from claim 1) is selected from a Markush group of (meth)acrylates. Applicants believe that the Examiner's objection is to the second occurrence of (meth)acrylate in line 2 of claim 9. Claim 9 has been amended to insert "methyl" immediately before the second occurrence of (meth)acrylate in line 2. Support for this amendment is found on page 6, line 11 of the specification. Applicants note that the Markush group recited on page 6, lines 8-19, is the same Markush group as that recited in amended claim 9. Again, the Applicants wish to thank the Examiner for calling attention to this omission.

Double Patenting

Claims 25 and 26 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 20 of copending Application No. 10/696,093. Applicants believe that this rejection applies to original claim 25 and claims 26 and 27 as renumbered by amendment in this paper. Since the present application and that to which the double patenting rejection refers are copending, this rejection is provisional. Accordingly, Applicants will defer any action on this rejection until other issues with the present claims have been resolved. Applicants intend this deferral to be without prejudice to any action available under the statutes and regulations.

Applicants affirm that this application and the '093 application were commonly owned at the time the invention of the present application was made. The assignment in the '093 application was recorded on February 20, 2004 at Reel/Frame 014361/0788 and the assignment in this application was recorded on March 17, 2004 at Reel/Frame 014435/0320. Both assignments were made by all inventors for the benefit of E.I. du Pont de Nemours and Company as sole assignee.

Application No.: 10/696088
Docket No.: FA1062USNA

Page 6

Status of the Application

Claims 1-27 (as renumbered) are pending in the application. Claims 1-27 stand rejected under 35 U.S.C. §102(b), 35 U.S.C. §103(a), or both in the alternative. Each rejection is addressed under a separate subheading below, in the order set forth in the Office Action.

Claims 1 and 25 have been amended to advance the prosecution by changing preamble language "comprising" to "consisting essentially of".

Claim Rejections

Claim Rejection - Barsotti (US 4,411,951)

Claims 1-11, 13-16, 18, 19, 21-23, 25 and 26 are rejected under 35 U.S.C. §102(b) as anticipated by Barsotti.

Barsotti discloses a coating material that includes an acrylic resin, a rheology control agent, and requires a polyglycol (please see the Abstract, Examples 1 and 2), or three essential components, while the corresponding component of the present claims require a copolymer and a rheology control agent. The coating composition of the claims under review do not require a polymeric glycol, and are therefore distinct from the Barsotti coating in that Barsotti does not enable the presently claimed coating.

The foregoing comparison between the present claims and the Barsotti disclosure demonstrates that the reference does not disclose all of the limitations of the claims under consideration arranged as in the claims of the application. Therefore, Barsotti does not anticipate the instant claims.

Claim Rejection - Barsotti in view of Loney Crawford (US 5,612,415)

Claims 20 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barsotti in view of Loney-Crawford. Applicants have distinguished the acrylic acid functional crosslinkable component from the acrylic polymer binder of the prior art hereinabove. If, as Applicants submit, the coating composition is novel based upon the amendment to claim 1 and the foregoing remarks, then this rejection is rendered moot, since a dependent claim that depends, directly or indirectly, from a novel independent claim is itself novel and non-obvious.

Applicants respectfully traverse the Examiner's characterization of claim 24 as relating to a result effective variable (asserted to be the amount of crosslinkable component in the composition). Claim 24 recites the range of acid functional copolymers in the crosslinkable component. Claim 1 recites that the crosslinkable component of the coating

Application No.: 10/696088
Docket No.: FA1062USNA

Page 7

composition consists essentially of an acid functional acrylic copolymer polymerized from a monomer mixture comprising 2% to 12% of one or more carboxylic acid group containing monomers. Claim 24 recites that the crosslinkable component comprises 5% by weight to 25% by weight of one or more acid functional acrylic copolymers based on the total weight of the crosslinkable component. Applicants respectfully assert that the percentages given in claim 1, as amended to incorporate the limitations of claim 24, are ranges not recognized in the prior art to be result-effective variables. As presented in the specification, if the amount of carboxylic acid group containing monomer in the monomer mix exceeds the upper limit, the resulting coatings would have unacceptable water sensitivity and if the amount is less than the lower limit, the resultant coatings would have insignificant strike-in properties (please see the specification at page 4, lines 26-31). If the composition of the invention contains excess of the upper limit of the acid functional copolymer in the crosslinkable component, the resulting composition tends to have higher than required application viscosity; if the composition contains less than the lower limit of acid functional copolymer in the crosslinkable component, the resulting coating would have insignificant strike-in properties (please see the specification at page 4, lines 15-20).

Claim Rejection - Barsotti in view of Bederke (US 5,473,032)

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Barsotti in view of Bederke. Applicants submit that the claim amendments and remarks render this rejection moot, since if the coating composition is novel, as Applicants respectfully assert, then this dependent claim would be valid as depending from a valid independent claim.

Claim Rejection - Briggs (US 5,360,644)

Claims 1, 4-11, 13-16, 18, 19, and 21-26 are rejected under 35 U.S.C. §102(b) as being anticipated by Briggs. This reference does not enable the coating as claimed herein. Specifically, Briggs requires limitations not present in the claims under review. Briggs discloses a coating system in two distinct layers, a color layer and a clear layer (Col. 4, lines 18-37). For example, the clear layer of the composite coating in Briggs requires an epoxy-functional component and either an acid-functional or anhydride-functional component. The present claims require neither an epoxy-functional component, nor an anhydride-functional component, nor a copolymer of these components. The working example in Col. 9, cited by the Examiner, similarly requires an epoxy-functional acrylic polymer, which is not claimed in the present application. Briggs does not address at all the proper percentage of acid-functional monomers in a monomer mix.

Application No.: 10/696088
Docket No.: FA1062USNA

Page 8

Accordingly, Briggs does not enable the Applicants' invention and therefore does not anticipate the claims under review.

Claim Rejection - Briggs

Claims 2 and 3 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Briggs. Applicants respectfully traverse this rejection. Applicants respectfully reassert that Briggs does not disclose each and every element of, and does not enable, the claims under review herein. *In re Strada*, 15 USPQ2d 1655 (CAFC 1990) cited by the Examiner required virtually identical monomers and employing the same or similar polymerization techniques. *Id.*, 1567-68. The uncatalyzed basecoat in Briggs in comparison with Copolymer 1 of the application have the following compositions:

Briggs	Sty	BMA	EHA	mod. HEA		AA
[Conc](%)	34	20	15	24		7
Appln	Sty	BA	IBOA	HPMA	HEMA	MAA
[Conc](%)	20	40	20	7.5	7.5	5

Table 7 of the application (page 22) shows the acid functional acrylic copolymers present at 15.9%, with one instance at 4.3%, and Table 8 (page 23) shows the (meth)acrylic acid present at 10%, with one instance at 2.7. These are not virtually identical polymers. The comparisons in *Strada* show much closer identities of monomers and respective concentrations over the three monomers in each of the *Strada* application and the prior art reference to which comparison was made. Please see *Strada* at 1656, Col. 2 (beginning with the caption The Smith Reference) to 1657, Col. 1.

Applicants respectfully request that this rejection be withdrawn.

Claim Rejection - Bederke (US 5,473,032)

Claims 1-9, 11-16, 18-19, and 21-26 are rejected under 35 U.S.C. §102(b) as anticipated by Bederke. The limitations in, and those added by amendment to, independent claims 1 and 25 recite limitations not present in this reference. In addition, Bederke requires amides and/or N-amides of acrylic and/or methacrylic acid and phenylalkyl esters of acrylic and/or methacrylic acid, limitations that are not required in the present claims. By virtue of the coating components required by Bederke that are absent from the present claims, Bederke

Application No.: 10/696088
Docket No.: FA1062USNA

Page 9

does not enable any of the rejected claims. Applicants respectfully submit that this rejection is overcome or rendered moot.

Claim Rejection - Briggs or Bederke in view of Loney-Crawford

Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Briggs or Bederke individually, in view of Loney-Crawford. The only asserted difference between the pending claims and the primary references is that claim 20 recites a two-pack coating composition. As asserted above, if the independent claim from which this claim depends is novel and unobvious, as Applicants believe, then this claim is non-obvious.

Claim Rejection - Strauss (US 5,340,868) or Briggs
or Bederke individually, in view of Barsotti

Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Strauss or Briggs or Bederke individually, in view of Barsotti. Applicants respectfully reassert the argument made immediately above.

Rehfuss (US 4,524,173)

Rehfuss was cited as an X reference in the International Search Report. As the Examiner has noted, the fumed silica is outside the claimed range. The presence of an optional acid monomer is also present outside the claimed range (please see Rehfuss at Col. 4, lines 3-6).

Conclusion

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Applicants hereby request a three-month extension of time within which to file this paper as authorized by 37 C.F.R. §1.136(a) and authorize the fee for that extension, as required by 37 C.F.R. §1.17(a)(3) to be paid from Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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